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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/217,878	12/21/1998	GREGORY SCOTT DUNCAN	VTN-415	3825

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EXAMINER

SIPOS, JOHN

ART UNIT PAPER NUMBER

3721

DATE MAILED: 10/08/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/217,878

Applicant(s)

DUNCAN ET AL.

Examiner

John Sipos

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-35 and 47-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 26-35 and 47-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 as failing to adequately teach how to make and use the invention, i.e. failing to provide an enabling disclosure. (A rejection of claims based on this objection follows this paragraph.) The disclosure does not disclose the two separate embodiments of multiple lower platens and multiple upper dies in a single machine. Note page 13, lines 8-15. Newly submitted claim 47 is the substantial equivalent of claim 36 which was cancelled after a similar 35USC112, first paragraph, rejection made in the Office action of May 22, 2002. ^{Gr} **Claims 47 and 48** are rejected under **35 U.S.C. ' 112, first paragraph**, as being predicated on an **insufficient disclosure** for the reasons set forth in the objection to the specification set forth above. The claim 26 and 47 combination further has no support in the specification in that claim 26 sets forth the use of "a mandrel" and by implication its cooperation

or movement (although never claimed) with the lidstock while claim 47 defines the mandrel as "a plurality of individually actuated dies". The disclosure does not provide support for both the moving of the single mandrel and a further means for individually actuating the plurality of dies, i.e. two moving means for the dies.

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26-35 and 47-51 are rejected under 35 U.S.C. ' 112, **second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedence for the phrase "the pressure between said mandrel and each of said platens" of lines 16 and 17 in claim ²⁶~~1~~. The relationship of the mandrel and the platens is not previously recited nor is the function of applying "pressure" by these elements. Note that claim 26 doesn't even recite a means for moving either the mandrel or the platens.

The following is a quotation of the third and fourth paragraphs of 35 U.S.C. ' 112:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

Claims 47 and 48 are rejected under 35 U.S.C. ' 112, **fourth paragraph**, as being indefinite and not further limiting the claim on which it depends.

The specification sets forth on page 8, line 12, et seq. that the single mandrel 32 is vertically movable. On page 13, line 8 et seq. the specification states that the “mandrel 32 may comprise plural individually actuated dies 70”. This language implies the replacement of the single mandrel with a single actuator with a plurality of dies and a plurality of individually controlled actuators. If the intention of claim 47 is similarly to replace the mandrel of claim 26 with a plurality of dies and since the disclosure does not provide support for both a single movable mandrel carrying a plurality of movable dies (see above 35USC112, first paragraph rejection), the elimination of the “a mandrel” of claim 26 by further defining it as a “plurality” of dies in dependent claim 47 does not further define the invention as required by 35USC112, fourth paragraph.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 26-30 and 47-49 are rejected under 35 U.S.C.103(a) as being unpatentable over the patent to Kuethe (5,155,969 – cited by applicant) in view of Highberger (5,836,136) or Connor (4,511,044). The Kuethe device comprises a plurality of carriers (16) carrying containers (25), a plurality of vertically moveable lifts (68,70,72 and 74), a plurality of platens (52,54,56,58) one on each of the lifts, a plurality of mandrels (44,46,48,50) above the platens and a lidstock maneuvering system (30+) for placing a lidstock sheet between the containers on the carriers and the mandrels which seal the lidstock to the containers to form a set of packages. The packages are subsequently separated after leaving the machine. The main difference between the machine of Kuethe and the claimed invention is the number of containers on each platen. The Kuethe devices

uses two containers 25 and 26 on each platen but it would have been obvious to one of ordinary skilled in the art to use one or any number of containers since the number is merely a matter of design consideration and duplication of parts. Furthermore, the number of containers being operated on is merely a matter of experimentation to develop the optimum and most efficient machine operation. Regarding the number of mandrels used, it is well known in the art to use a single mandrel to seal a plurality of containers if individual control of the sealing operation is not necessary or desired. It therefore would have been obvious to one of ordinary skilled in the art to use a single mandrel in the Kuethe machine to seal a plurality of containers. Furthermore, since Kuethe shows the use of a plurality of mandrels (as claimed in instant claim 47), one mandrel as claimed in claim 1 is present in the machine. The specific product being packages is given little patentable significance in apparatus claims since it does not affect the structure of the device.

The Kuethe device lacks the controlling of the pressure in the sealing head. The patents to Highberger and Connor each shows a packaging device comprising of opposing reciprocating sealing surfaces (30,32, and 24,26, respectively), pressure transducer for sensing the pressure between the surfaces (52 and 22, respectively) and control means (Figure 2 and Figure 12, respectively) that respond to signals received from the transducer to control the pressure being applied by the sealing surfaces (see column 10, line 48-57 and column 7, line 24 et seq., respectively). These pressure control control the quality of the sealed package. It would have been obvious to one skilled in the art to control the pressure applied by the sealing platens and mandrel of Kuethe as taught

by Highberger or Connor to prevent the manufacturing of packages with defective seals. Regarding claims 48 and 49, the mounting of the transducer to either the mandrel or the lift is a matter of design. Applicant has not disclosed that placing it on the mandrel or the lift provides an advantage, is used for a particular purpose, or solves a stated problem. Therefore, it would have been an obvious matter of design choice to modify Kuethe and the Highberger/Connor combination to obtain the invention as specified in claims.

Claims 31-35, 50 and 51 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Kuethe in view of Edwards (5,565,059 – cited by applicant) or Edwards (5,528,878) and of Highberger (5,836,136) or Connor (4,511,044). The patent to Kuethe does not specifically teach the inspection of the packages. The patents to Edwards shows a contact lens packaging system wherein an inspection system verifies the proper alignment of the printed matter on the lidstock within the machine (see column 8, lines 30-36 and column 10, line 1, respectively). It would have been obvious to one skilled in the art to provide the packaging a system of Kuethe with an inspection system such as disclosed by Edwards to ensure proper registration of the lidstock with the containers. Regarding the pressure control, see the comments made in the first art rejection made above.

Claims 26-35 and 47-51 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Ciba Geigy(WO 98/32587) – cited by applicant) and of Highberger (5,836,136) or Connor (4,511,044). The Ciba device comprises a plurality of carriers (1) carrying containers (3), a plurality of vertically moveable lifts (61), a plurality of platens (top portions of 61) one on each of the lifts, a plurality of mandrels (70) above the platens and a lidstock maneuvering system for placing a lidstock sheet between the containers on the carriers and the mandrels which seal the

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lidstock to the containers to form a set of packages. The main difference between the machine of Ciba and the claimed invention is the number of containers on each platen. The Ciba devices uses more than one container on each platen but it would have been obvious to one of ordinary skilled in the art to use one or any number of containers since the number is merely a matter of design consideration and duplication of parts. Furthermore, the number of containers being operated on is merely a matter of experimentation to develop the optimum and most efficient machine operation. Regarding the number of mandrels used, it is well known in the art to use a single mandrel to seal a plurality of containers if individual control of the sealing operation is not necessary or desired. It therefore would have been obvious to one of ordinary skilled in the art to use a single mandrel in the Ciba machine to seal a plurality of containers. Regarding the pressure control, see the comments made in the first art rejection made above.

Claims 26-28,35 and 47-49 are rejected under **35 U.S.C. 103(a)** as being unpatentable over the patent to Giovannone (5,379,572) in view of Kuethe and Highberger (5,836,136) or Connor (4,511,044).. The patent to Giovannone shows a packaging machine which comprises a plurality of carriers (read on the portion of the conveyor holding/pushing each blister), a plurality of vertically moveable lifts 22,32,42, a plurality of platens 26,36,46 on the lifts, a plurality of mandrels 20,30,40 above the platens and a lidstock maneuvering system 16 for placing lidstock between the blisters on the carriers and the mandrels which seal the lidstock to the blisters. It would have been obvious to one of ordinary skilled in the art to provide the lidstock of Giovannone in a continuous sheet form that is subsequently cut to any size as shown by Kuethe to ease the positioning of the lidstock in the sealing mechanism. The specific product being packages is given little patentable significance in apparatus claims since it does not affect the

structure of the device. Regarding the pressure control, see the comments made in the first art rejection made above.

Claims 29-34,50 and 51 are rejected under **35 U.S.C.103(a)** as being unpatentable over the patent to Giovannone in view of Kuethe (as applied above) and further in view of Edwards (5,565,059 – cited by applicant) or Edwards (5,528,878) and Highberger (5,836,136) or Connor (4,511,044).. The patent to Kuethe does not specifically teach the inspection of the packages. The patents to Edwards shows a contact lens packaging system wherein an inspection system verifies the proper alignment of the printed matter on the lidstock within the machine (see column 8, lines 30-36 and column 10, line 1, respectively). It would have been obvious to one skilled in the art to provide the packaging a system of Kuethe with an inspection system such as disclosed by Edwards to ensure proper registration of the lidstock with the containers. Regarding the pressure control, see the comments made in the first art rejection made above.

ADDITIONAL REFERENCES CITED

The following prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The cited references show the controlling of the pressure of the sealing surfaces during a package sealing operation.

RESPONSE TO APPLICANT'S ARGUMENTS

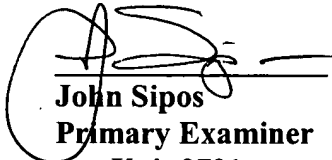
Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9302**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.


John Sipos
Primary Examiner
Art Unit 3721

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